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### PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional) 8285/389

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On February 12, 2007

Signature

Typed or printed

Name Scott W. Brim

Application Number

09/652,540

Filed

August 31, 2000

First Named Inventor Carol Gruchala

Art Unit

2614

Examiner

Nguyen, Quynh H.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five(5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

☒ attorney or agent of record.

Registration number 51,500

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34.         

  
Signature

Scott W. Brim

Typed or Printed Name

312 321-4200

Telephone number

Note: Signatures of all inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.\*

February 12, 2007

Date

☒ \*Total of 1 forms are submitted.



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Attorney Docket No.: 8285/389

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:	)	
	)	
Carol Gruchala	)	
	)	Examiner: Nguyen, Quynh H.
Serial No.: 09/652,540	)	
	)	Group Art Unit No.: 2614
Filing Date: Aug. 31, 2000	)	
	)	
For: METHOD, SYSTEM AND	)	
ARTICLE FOR PROVIDING A	)	
FAMILY TELECOMMUNICATION	)	
SERVICE USING AN	)	
ORIGINATING DUAL-TONE	)	
MULTI-FREQUENCY TRIGGER	)	

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandra, VA 22313-1450

Dear Sir:

Applicants request review of the final rejection in the above-identified application.

No amendments are being filed with this request.

This request is being filed with a notice of appeal

The review is requested for the reasons stated on the attached sheets. No more than five (5) pages are provided.

## REMARKS

### I. Introduction

Claims 1-17 are pending in the application. In the final Office Action dated Nov. 14, 2006, the Examiner rejected claims 1-17 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 6,879,676 ("Contractor") in view of U.S. Pat. No. 5,953,401 ("Caveney"). Applicants request review of the rejections against the claims.

### II. It Is Improper to Combine Contractor and Caveney

It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983); MPEP §§ 2141.02 and 2145. Caveney is directed to a call processor for use with a telephone switching system that allows an incoming caller to complete the call to an internal destination ***without operator assistance and without receiving a generated voice message***. (Abstract). The portion of Contractor cited by the Examiner discloses providing a routing menu to a caller, which is the very action that Caveney is attempting to avoid. Applicants respectfully submit that due to the fact Caveney teaches away from a user receiving a generated voice message such as a menu, and the portion of Caveney cited by the Examiner discloses a user receiving a generated voice message such as a menu, it is improper to combine Contractor and Caveney as contemplated by the Examiner.

### III. The Proposed Combination Does Not Render Claim 1 Unpatentable

Claim 1 is directed to a method for providing a telecommunication service. Claim 1 recites providing a menu to a caller from a telephone network element in a telephone call, the menu providing a plurality of destination options including a first destination option for a residence of a family, a second destination option for a first member of the family at a first location other than the residence, and a third destination option for a second member of the family at a second location other than the residence. The Examiner has admitted that Caveney does not teach providing a menu to a caller. The only reference cited by the Examiner that provides a menu to a caller is Contractor. However, Contractor fails to teach the above-recited element.

Contractor is directed to a system and method for routing a call to an optimal location. In the portion of Contractor cited by the Examiner, a user calls a main number for a conglomerate of car dealerships and is provided a menu for selecting which specific car dealership the caller would like their call routed to. For example, a caller may choose to route their call to a BMW dealership, a Ford dealership, or a Toyota dealership. Contractor does not disclose providing a menu for routing a call to different locations associated with a family as recited in claim 1 such as a first destination option **for a residence of a family**, a second destination option **for a first member of the family at a first location other than the residence**, and a third destination option **for a second member of the family at a second location other than the residence**.

The specification of the current application defines family members as blood relationships such as a parent of a child or legal relationships such as a legal guardian of a child. In the Office Action, the Examiner asserts that Contractor discloses that for a conglomerate of car dealerships, a different family member owns each car dealership. Applicants respectfully disagree. Contractor does not disclose that for a conglomerate of car dealerships, a different family member owns each car dealership.

Because both Contractor and Caveney fail to disclose at least providing a menu to a caller from a telephone network element in a telephone call, the menu providing a plurality of destination options including a first destination option for a residence of a family, a second destination option for a first member of the family at a first location other than the residence, and a third destination option for a second member of the family at a second location other than the residence, the proposed combination of Contractor and Caveney as contemplated by the Examiner necessarily cannot render independent claim 1, or any claim that depends on claim 1, unpatentable.

#### **IV. The Proposed Combination Does Not Render Claim 5 Unpatentable**

Claim 5 recites at least one service control point including service logic to direct the act of providing a menu to a caller in a telephone call in response to a first trigger, the menu providing a plurality of destination options including a first destination option **for a residence of a family**, a second destination option **for a first member of the family at a first location other than the residence**, and a third destination option **for a**

**second member of the family at a second location other than the residence.** As discussed above, Contractor and Caveney fail to disclose at least this element. For at least this reason, the proposed combination of Contractor and Caveney as contemplated by the Examiner necessarily cannot render independent claim 5, or any claim that depends on claim 5, unpatentable.

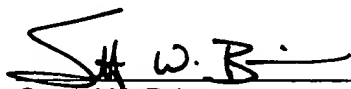
**V. The Proposed Combination Does Not Render Claim 9 Unpatentable**

Claim 9 is directed to a computer-readable medium having computer-readable data which directs one or more telephone network elements to perform the act of providing a menu to a caller in a telephone call, the menu providing a plurality of destination options including a first destination option **for a residence of a family**, a second destination option **for a first member of the family at a first location other than the residence**, and a third destination option **for a second member of the family at a second location other than the residence.** As discussed above, Contractor and Caveney fail to disclose at least this element. For at least this reason, the proposed combination of Contractor and Caveney as contemplated by the Examiner necessarily cannot render independent claim 9, or any claim that depends on claim 9, unpatentable.

**VI. Conclusion**

Applicants submit that the pending claims are in condition for allowance and request review of the final rejection in the above-identified application.

Respectfully submitted,

  
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Attorney for Applicants

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